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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,285	05/04/2006	Klaus Sickert	DE03 0374 US1	1830
65913	7590	09/20/2007		
NXP, B.V. NXP INTELLECTUAL PROPERTY DEPARTMENT M/S41-SJ 1109 MCKAY DRIVE SAN JOSE, CA 95131			EXAMINER ROJAS, PEDRO A	
			ART UNIT 2876	PAPER NUMBER
			NOTIFICATION DATE 09/20/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip.department.us@nxp.com

## Office Action Summary

Application No.

10/578,285

Applicant(s)

SICKERT ET AL.

Examiner

PEDRO A. ROJAS

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/04/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/04/2006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The references listed in the information disclosure statement (IDS) submitted on 5/04/2006 have been considered by the examiner (see attached form PTO-1449).

### ***Specification***

2. The abstract of the disclosure is objected to because it exceeds the required limit of 150 words. Correction is required. See MPEP § 608.01(b).
3. The disclosure is objected to because of the following informalities:  
  
The disclosure lacks the preferred layout (see below) of a utility application. It is recommended that applicant amend the specification according to the preferred layout.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

**Appropriate correction is required.**

*Claim Objections*

4. Claim 7 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

5. Claims 1-3, and 5-7 are objected to because of the following informalities:

Re Claim 1:

- On lines 2-3, “the contactless transmission” and “the contactless exchange” lack antecedent basis;
- On line 5, the phrase “having at least one first area or...” is unclear whether it refers to the data carrier or the base station;
- on line 17, the phrase “and is designed such that...” is unclear as to what applicant is referring to.

Re Claim 2:

- the recitation “the capacitive element assumes its full area on the data carrier...” it is unclear as to which one of the first and second areas applicant is referring to. Additionally, it is unclear as to what element the possessive pronoun “its” is referring to.

Re Claim 3:

- on line 3, it is unclear whether the recitation “(40a)” is part of the claimed invention;
- on lines 4-5, the phrase “different areas that are individually connected to one another;” it is unclear to which areas applicant is referring. The Examiner notes that first and second areas have been previously recited in claim 1; therefore, it would be proper to refer back to said first and second areas or define new ones if necessary;

- on lines 8-9, “the selected electrical connection” and “the individual part-areas” lack antecedent basis.

Re Claim 5:

- in the phrase “the part-areas of the capacitive elements”, there is a lack of antecedent basis for “the part-areas” and it is unclear as to which areas applicant refers to. The Examiner notes that first and second areas (as in claim 1), and individual part-areas (as in claim 3) have been defined previously; it would be proper for applicant to refer to previously defined areas or define new ones if necessary;
- in the phrase “is informed of the coding through the information...” is unclear as to who is informed, and there is a lack of antecedent basis on “the coding” and “the information”;
- in the phrase “in the event of identical selection of the electrical connections of the individual plate surfaces” it is unclear as to how a selection is made, and identical to what. Additionally, there is lack of antecedent basis for the following: “the event”, “the electrical connections”, and “the individual plate surfaces”.

Re Claim 6: substitute “as well as” with -- and --.

Re Claim 7:

- it is unclear as whether the phrase “(a so-called M[achine]R[eadable]T[ravel]D[ocument],” is part of the claimed invention;
- the phrase “residence pennit” is unclear because there is not proper definition for the word “pennit”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Regarding claims 1-7, the phrases "in particular", "essentially", "such as", and "for example" throughout the recitation of the claims renders the claims indefinite because it is unclear whether the limitation(s) following said phrases are part of the claimed invention. See MPEP § 2173.05(d).
3. Claim 7 provides for "[t]he use of at least one electrical or electronic carrier or document carrier..." but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 7 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1- 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over TAMURA at al. (hereafter "Tamura")—Japanese Patent Application publication No.: JP2001092934 published on 4/06/2001—in view of Pickett et al. (hereafter "Pickett")—U.S. Patent No.: 5,451,763.**

**Regarding Claims 1-6:** Tamura (see FIGs 1-8 and entire machine-translated documents) discloses an electronic data carrier in the form of an identification card 10 designed for contactless communication with a read/write base station (not shown); said data carrier comprising:

- first and second page areas;
- one connection axis 16 provided between said first and second page areas, wherein said first and second page areas can folded apart from or towards one another between unfolded and folded positions determining thereby an open state and a closed state respectively, and wherein said data carrier is operable to transmit/receive information in the unfolded (i.e. open state) and said data carrier is inhibited from transmitting/receiving information in the folded (i.e. closed state);
- at least one electronic circuit 20;

- at least one coupling element 22 conductively connected to said circuit 20 for transmitting/receiving information to/from a read/write base station (not shown), wherein the coupling element is embedded into said first and second page areas.

Regarding claims 1-6, Tamura does not expressly disclose the coupling element is designed as at least one capacitive element, wherein the coupling element is designed in the form of a capacitive plate.

Pickett discloses reading data from, writing data to and storing data in an electronic data carrier (IC card), utilizing an external read/write unit. The data carrier (IC card 12) comprises capacitive plates 24 and 26 disposed on the card's substrate 86. The read/write unit comprises capacitive plates 36 and 38 disposed such that when the card 12 is disposed within the receptacle 16, the card's capacitive plates 24 and 26 are proximate to the read/write unit capacitive plates 36 and 38. Information data is capacitively transferred between IC card 12 and the read/write unit via corresponding capacitive plates. The data carrier may be programmed for data protocols and access codes so that different data protocols may be used to input data and the data may be protected using a PIN. See Abstract, FIGs 1-5 with corresponding descriptive text (C3,L64 thru C7,L10).

Tamura and Pickett disclose an electronic data carrier comprising at least one coupling element designed for communication with a read/write base station.

It would have been obvious at the time the invention was made to one of ordinary skill in the art to modify and/or add an at least one coupling element in the form of at least one capacitive plate (as taught by Pickett) in the invention of Sakae for the benefit of—for example—realizing an electronic data carrier at minimal thickness with high mechanical flexibility and operable to



precisely tune to the correct communication frequency that a read/write base station might work. As taught by Pickett (C6,L20-23), capacitive plates may be manufactured from conductive materials such as titanium, which is known to those skilled in the art high mechanical flexibility even if used in minimal amounts. Additionally, as it is commonly known to those skilled in the art, the coupling capacitance (and thereby the communication frequency) between the data carrier and a read/write base station would be easily changed (i.e. tuned) by varying the distance between the corresponding capacitive plates.

#### ***Additional Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. Patent No.: 5,710,421 to Kobuku discloses a data carrier in the form of an IC card composed of first and second halves connected by a self hinge portion so as to be foldable. When folded the card works as a non-contact IC card, whereas when unfolded the card works as contact type card.
- Patent Application Publication US 2005/0236489 A1 disclosed by Francois Droz teaches a portable information device equipped with a transponder capable of being activated when open (unfolded) and deactivated when closed (folded) during communication with a suitable contactless reader.
- Japanese Patent Application publication No.: JP2004005494A published 3/20/2003 discloses an IC card system for easily changing the communication frequency without using a switch by changing the inductance of an antenna coil in a folded state and non-folded state of the card body.

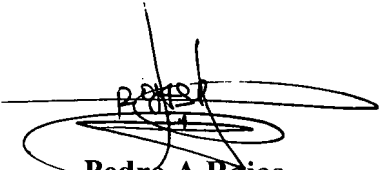
### ***Conclusion***

***Examiner's Note:*** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEDRO A. ROJAS whose telephone number is (571) 270-1618. The examiner can normally be reached on MON-FRI 7:30am - 5:00pm, alt. FRI EST Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G. LEE can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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